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In re Application of :
SHUSTER et al. :
Application No.: 10/500,499 : DECISION
PCT No.: PCT/US02/41850 :
Int. Filing Date: 31 December 2002 :
Priority Date: 31 December 2001 :
Attorney Docket No.: 14848-007US1 :
For: METHODS AND MATERIALS FOR :
MODULATING ENAC-BETA :

This is a decision on applicants' petition under 37 CFR 1.47(a) filed 03 December 2004 in the United States Patent and Trademark Office (USPTO).

BACKGROUND

On 31 December 2002, applicants filed international application PCT/US02/41850, which designated the United States and claimed a priority date of 31 December 2001. A copy of the international application was communicated from the International Bureau to the USPTO on 17 July 2003. The thirty-month period for paying the basic national fee in the United States expired at midnight on 30 June 2004.

On 29 June 2004, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee and an assertion of small entity status.

On 26 August 2004, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventor in compliance with 37 CFR 1.497(a)-(b), an initial or substitute computer readable form (CRF) of the "Sequence Listing", and an initial or substitute paper copy of compact disc of the "Sequence Listing" as well as an amendment directing its entry into the specification, were required. The NOTIFICATION set a two-month extendable period for reply.

On 03 December 2004, applicants filed, *inter alia*, a petition/fee for a two month extension of time, the surcharge under 37 CFR 1.492(e) for providing the oath or declaration later than thirty months from the priority date, a paper copy of the sequence listing as well as an

amendment directing its entry into the specification, a CRF of the sequence listing, and the instant petition under 37 CFR 1.47(a) which was accompanied by several declarations of inventors and a supporting declaration of facts by M. Angela Parsons.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17(h); (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the missing inventor; and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

As to item (1), the petition fee under 37 CFR 1.17(g) as of 22 November 2005 is \$200. Applicants have paid \$130. The balance of \$70 has been charged to Deposit Account 06-1050.

Items (3) and (4) have been satisfied.

Item (2) has not been satisfied. As noted in MPEP § 409.03(d), the statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Here, it is not clear that M. Angela Parsons has firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Additionally, it is not clear whether it is being alleged that non-signing inventor Ulf N.G. Arvidsson refuses to execute the application or that he cannot be reached after diligent effort. A communication was purportedly sent to Mr. Arvidsson's last known address at an undisclosed time. It is not clear whether Mr. Arvidsson resided at this address at the time. (The statement of facts indicates that the package was signed for by a person other than Ulf N.G. Arvidsson. Mr. Arvidsson may still reside at that address, however.) Accordingly, it is not clear if the inventor is no longer at this address and his whereabouts are unknown, or if he simply received the mailing and did not respond. If the mailing was received and the inventor did not respond, then a refusal to execute the application would likely need to be established. To establish a refusal to execute, *inter alia*, the non-signing inventor must be presented with a copy of the application papers including the specification, claims and drawings. Here, it is not clear that a copy of the application papers including the specification, claims and drawings was sent to Mr. Arvidsson. Rather, the declaration of M. Angela Parsons suggests that only a combined Declaration/Power of Attorney document was sent to him. See MPEP § 409.03(d). If it is being alleged that the inventor cannot be reached or found, copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, and telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the affidavit or declaration.

CONCLUSION

For the above reasons, applicants' petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. **Failure to timely file the proper response will result in abandonment of this application.** Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)". No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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